

REMARKS

Applicants thank the Examiner for the thorough examination of the application. Claims 1-13 are pending. By this Amendment, claims 1, 2 and 6 are amended. No new matter is believed to be added to the application by this Amendment.

Status of the Claims

Claims 1-13 are pending in the application. Claim 1 has been amended to incorporate certain features of previously presented claims 2 and 6. Claim 1 finds support in claims 2 and 6, for example. Claim 6 has been amended to incorporate a feature of previously presented claim 2, finding support in previously presented claim 2.

Entry of Claim Amendments

Applicants respectfully submit that it is proper to enter and consider the amendments on their merits because they do not raise any new issues that have not already been presented and considered and because they clearly are allowable for reasons set forth below.

These amendments merely remove certain subject matter from claims 2 and 6 and place it in claim 1 and remove certain subject matter from claim 2 and place it

into claim 6. The claimed subject matter has already been considered on its merits and the amended claims do not present any issues that will require further consideration and/or search.

Drawings

Applicants thank the Examiner for accepting the drawing change made in the Amendment filed November 17, 2003.

Rejection Based on 35 USC §102(b)

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the Applicants' disclosure. This rejection is respectfully traversed.

In the first place, Applicant has not admitted that Figures 1-3 are prior art to them. In Fleming v. Giesa (BdPatApp&Int) 13 USPQ2d 1052 (7/17/1989) it was held that for an admission to be used against a party, it must be clear, unequivocal and unmistakable. See also, Harner et al. v. Barron et al., 215 USPQ 743 (Comr Pats 1981), Suh v. Hoefle (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991), Issidorides v. Ley (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985) and Ex parte The Successor In Interest Of Robert S. McGaughey (BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988).

All that Applicant has done is to refer to Fig. 1 as "Conventional Art." Something can be conventional art in the sense that it is practiced in the real

world at the time of Applicant's filing of this Application and may yet not be prior art to Applicant in any sense, including, for example, under 35 USC §103, which forms the basis for this rejection. See, in this regard, the relatively recent amendments to 35 USC 103(c).

Under the circumstances, i.e., where Applicant merely describes Fig. 1 as conventional art, the Office Action has not established that Applicant has made a clear, unequivocal and unmistakable admission on the record that what is disclosed in Fig. 1 is prior art to Applicant. In this regard, the Examiner is also advised that the initial burden to establish something as prior art is on the Office as part of its burden of making out a *prima facie* case of unpatentability.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Applicant respectfully submits that the Office has not made out a *prima facie* case of unpatentability at least because it has not made out a *prima facie* case that Fig. 1 is prior art to Applicant. Accordingly, this rejection is improper and should be withdrawn.

Moreover, even if Fig. 1 is considered prior art for the sake of argument, Fig. 1

alone or taken in connection with the applied secondary references, does not render Applicants' claimed invention obvious.

In Fig. 1, the data signal is transferred through the power line network 60 to the PLC modems 70 connected to the power line network 60 – see page 4, lines 15-22 and Fig. 1. The router and the power line network include PLC modems.

However, in the invention recited in amended claim 1, the network bridge includes an input protection means for protecting internal circuitry and for removing unwanted electric components of the data signal flowing between the telephone line network and the power line network, and matching means connected to the input means to match impedance of the data signal to an impedance value of the PNA modems – see Figs. 2 and 3). Additionally, the power line network of claim 1 recites modems having a coupler, a feature not disclosed in Fig. 1, and does not need the addition of a PLC modem. Accordingly, the network bridge recited in claim 1, differs from the conventional router disclosed in Fig. 1 and claim 1 is not anticipated by Fig. 1 of Applicant's disclosure.

Reconsideration and withdrawal of this rejection is respectfully requested.

Rejections under 35 USC §103(a)

Claims 2-5 are rejected under 35 U.S.C. §103(a) as being obvious over the Applicants' disclosure in view of Bullock (U.S. Patent 6,107,912). Claims 6-12 are rejected under 35 U.S.C. §103(a) as being obvious over the Applicants' disclosure in

view of Sanderson (U.S. Patent 6,040,759). Applicants respectfully traverse these rejections.

In rejecting claims under 35 USC §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Note, In re Oetiker,

977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Initially, as noted above, the Office Action has not made out a *prima facie* case that Fig. 1 is prior art to Applicant. For this reason alone, the rejection is improper and should be withdrawn.

Moreover, even if Fig. 1 is considered prior art for the sake of argument, Fig. 1 alone or taken in connection with the applied secondary references, does not render Applicants' claimed invention obvious.

Because claim 1 has been amended to include features recited in claim 6 which was pending when the outstanding rejection was made, Applicants will also argue the merits of claim 1 not only with respect to the rejection of claims 2-5

based in part on the Bullock reference but, also, with respect to the reference combination applied to previously pending claims 6-12, based in part on the Sanderson reference.

With respect to the outstanding rejection of claims 2-5 as allegedly being obvious over Applicants' Fig. 1 in view of Bullock, Applicants respectfully submit that the Office Action fails to demonstrate that one of ordinary skill in the art would be properly motivated to modify Fig. 1 in view of Bullock.

The only indication that changes to Fig. 1 are desirable is found in Applicants' disclosure separate and apart from the disclosure of the details of Fig. 1 and it is well settled that an Applicant's disclosure cannot be used against them, such being known as improper hindsight reconstruction of Applicants' invention based solely on Applicants' disclosure.

The alleged motivation in the Office Action to use Bullock to modify Fig. 1 is that Bullock teaches an extension unit coupled to a standard modem for connecting to a standard power line "to make compatible with standard modem equipment for transferring data over the power line," when the Office Action references the abstract and col. 3, line 50 through col. 4 line 55.

Applicants' response to this alleged motivational statement is that it is not evidence of proper motivation to modify Fig. 1 in view of Bullock. Instead, it is nothing more than a broad general statement about the teaching of Bullock and does not constitute a clear and particular statement of proper motivation.

Compare, Dembiczak, cited above..

Moreover, there is no teaching in Fig. 1 or in Bullock of replacing a PLC modem with a PNA modem and a coupler or of the desirability to do so. The only place that such a teaching is found in Applicants' own Application, which cannot properly be used against the Applicants in making an obviousness-type rejection.

The only blueprint to make the proposed modification to Fig. 1 is found in Applicant's disclosure.

Accordingly, this rejection fails to provide a *prima facie* showing of proper motivation to modify Fig. 1 in view of Bullock and, thus, fails to provide a *prima facie* showing of obviousness of the claimed invention, including the "PNA modem having a coupler" feature of amended claim 1.

Sanderson, relied on in the rejection of claims 6-12, is no more pertinent to the claimed invention than is Bullock. Sanderson does not disclose a network infrastructure integrated system that integrates a telephone line network and an electric power line network separately installed in a home into a single network, provides his couplers outside of homes – see Fig. 9, for example, and does not disclose employing PLC modems. Sanderson does not describe the claimed features of the network bridge that enable home information machines to communicate data signals between a telephone line network and the power line network. Sanderson concerns a high voltage cable between the outdoor power line network and the indoor customer premises (1120) and is not installed in a home

in a single network.

The claimed invention permits reduced cost compared to the Fig. 1 and enhances interchangeability and accessibility parameters.

The alleged motivation for using Sanderson to modify Fig. 1 is “because it cancels interference problems and prevents over-voltage.”

There is no disclosure in Sanderson that Fig. 1 has a problem that should be corrected, or that there is anything wrong with Fig. 1. In fact, Sanderson has nothing to do with Fig. 1. Sanderson is actually non-analogous art to Fig. 1. Sanderson does not even contemplate the type of home network system of Fig. 1. Nor is Sanderson reasonably pertinent to the problem with which the inventor is involved, because Sanderson does not have any disclosure of replacing a router using a PLC modem with a network bridge that does not have a PLC modem.

Nobody would turn to Sanderson to modify Fig. 1 unless they improperly, through hindsight, used Applicant’s disclosure, which includes the teaching of a shortcoming of Fig. 1 that can be rectified, as a blueprint. Compare, Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543m 547 (Fed. Cir. 1985).

Applicants respectfully submit that the Office Action completely fails to provide a *prima facie* case of proper motivation to modify Fig. 1 in view of Sanderson and, thus, fails to provide a *prima facie* case of obviousness of the claimed invention.

These rejections of claims 2-12 are, accordingly, improper and withdrawal thereof is respectfully requested.

The Office Action rejects claim 13 under 35 USC §103(a) as unpatentable over Applicants' Fig. 1 in view of U.S. Patent 6,529,589 to Nelson. This rejection is respectfully traversed.

Fig. 1 does not anticipate claim 1, from which claim 13 depends, for the reasons stated above. Nelson is characterized in the Office Action as teaching integrating the telephone line network and the power line network without using a router, and in view of this teaching, allegedly, it would be obvious to modify Fig. 1 to integrate the telephone line network and the power line network without using a router to achieve reduced processing power and power consumption.

Applicant respectfully points out that Nelson fundamentally differs from Fig. 1 and the fundamental difference between these references teaches away from combining them as suggested.

In the first place, the broad, general statement that Nelson discloses integrating a telephone line network and a power line network is not detailed and specific enough to provide evidence of proper motivation to modify Fig. 1 in any way, let alone in the way suggested in the rejection.

In the second place, the only power line connection in Nelson is between the phone line connection modem and the home automation equipment. Any possible modification of Fig. 1 by Nelson would therefore be confined to being between Fig.

1's PNA modems 30 and home information machines 40. However, any such modification would not result in the claimed invention, which recites the network bridge connected between the telephone line network and the power line network for enabling the first and second pluralities of home information machines to communicate data signals with each other between the telephone line network and the power line network.

Applicants respectfully submit that the Office Action completely fails to provide a *prima facie* case of proper motivation to modify Fig. 1 in view of Sanderson and, thus, fails to provide a *prima facie* case of obviousness of the claimed invention.

Accordingly, this rejection of claim 13 is improper and should be withdrawn.

Prior Art Cited by the Examiner

The prior art made of record but not relied upon by the Examiner shows the status of the conventional art that the invention supercedes. Additional remarks are accordingly not necessary.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J.

Amendment in Reply to February 11, 2004 Office Action
Application No. 09/880,857

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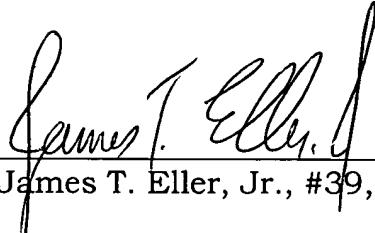
Webster, Reg. No. 46,472, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a Two (2) month extension of time for filing a reply in connection with the present application, and the required fee of \$420.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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